

REMARKS

This Amendment amends claim 11 and adds new claims 16-23. Support for the claim amendments and new claims is found, among other places, in the originally filed specification and claims. Claims 1-23 are now present in this application.

Applicants acknowledge the withdrawal of the previous Restriction Requirement and the treatment by the Office Action of all the claims.

The Office Action alleges that Fig. 11 on sheet 9 “should be designated by a legend such as --Prior Art-- because only that which is old is illustrated”. To eliminate this issue, Fig. 11 is amended by adding “Prior Art” to Fig. 11. A drawing sheet showing a proposed drawing correction to Fig. 11 in red ink and a replacement sheet having Figs. 11-14 with the correction are enclosed herewith.

Applicants respectfully submit that the amendment to Fig. 11 does not add new subject matter and meets the requirements of MPEP 608.02(g). Based on the foregoing, Applicants request admission of the amendment to Fig. 11.

The specification is objected to because the statement on page 10 of “gouge into the first conduit 16” appears to be incorrect. The specification is amended at paragraph 0059 to recite “gouge into the second conduit 18.” Applicants respectfully submit that the amendment to the specification does not add new subject matter and respectfully request admission of the amendment to the specification and withdrawal of the objection thereto.

Claims 1-15 are in the instant application of which claims 6, 7, 14, and 15 are objected to, and claims 1-5 and 8-13 are rejected. Applicants, by this Amendment, have amended claim 11 and have added new claims 16-23.

The Office Action alleges that claims 6, 7, 14, and 15 are dependent on rejected claims but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants acknowledge that claims 6, 7, 14, and 15 contain allowable subject. Claims 7, 14, and 15 are directly dependent on claim 1, and claim 6 is indirectly dependent on claim 1. Applicants have studied the rejection of claim 1 and believe that the discussion below clearly shows that the subject matter of claim 1 is patentably novel over the art. Based on the foregoing, Applicants propose to maintain claims 6, 7, 14, and 15 as dependent claims and, if another Amendment is necessary to move the application to allowance, will consider presenting claims 6, 7, 14, and 15 in independent form.

Claim 11 is rejected under 35 U.S.C. § 112, first paragraph. The Office Action alleges that claim 11 calls for “compressible sleeves” directed to the embodiment shown in Fig. 10; and claim 1 calls for the embodiment depicted in Fig. 17a. The Office Action concludes by alleging that there are two patentably distinct embodiments and, therefore, they cannot depend from each other.

Applicants respectfully traverse the rejection of claim 11 under 35 U.S.C. § 112, first paragraph. Applicants respectfully submit that claims 1 and 11 cover, among other things, the embodiments of the invention shown in Figs. 16-19c; however, to more positively recite Applicants’ patentably novel invention, claim 11 is amended to recite, among other things, that the clamp assembly includes at least one compressible member. Support for the amendment to claim 11 is found, among other places, in Figs. 19a-19c.

Applicants respectfully submit that the amendment to claim 11 does not add new subject matter and respectfully request admittance of the amendment to, consideration of, and withdrawal of the rejection of claim 11 under 35 U.S.C. § 112, first paragraph.

Claims 1 and 8-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,870,278 to Lee in view of European Patent Application No. 0 245 704 (hereinafter also referred to as “EP ‘704”). The Office Action states that Lee lacks a clamp assembly positioned adjacent the first hollow conduit and the second conduit, and that EP ‘704 teaches a clamp assembly positioned adjacent the first hollow conduit and the second conduit (see Figs. 1 and 9). The Office Action concludes by alleging that it would have been considered obvious to one of ordinary skill in the art to modify Lee to include the clamp assembly as taught by EP ‘704 in order to prevent the second conduit from sliding into the first conduit once the required extension of the second conduit has been established.

Applicants respectfully traverse the rejection of claims 1 and 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of EP ‘704 and request reconsideration thereof. Claims 8-10 are either directly or indirectly dependent on independent claim 1.

The Office Action alleges that it would have been considered obvious to one of ordinary skill in the art to modify Lee to include the clamp assembly as taught by EP ‘704 in order to prevent the second conduit from sliding into the first conduit once the required extension of the second conduit has been established. Applicants respectfully submit that the design of Lee prevents the second conduit from sliding into the first conduit once the required

extension of the second conduit has been established. More particularly, the ends 38 and 39 of the ratchet handles 37 are biased into outer surface of internally threaded ratchet ring 45 (see Fig. 7 of Lee), the ring 45 is threaded onto outwardly threaded shaft 23, and the threaded shaft 23 is threaded in internally threaded cylinder 21. The cylinder 21 has reaction pins 22 which are seated in slots 20 formed in outer surface of intermediate cylinder 16, and the intermediate cylinder 16 has pin means 17 mounted in detent slots 15 of the cylinder 12 (column 1, line 65 to column 2, line 32 of Lee). This arrangement maintains the threaded shaft 23 and the cylinders 21, 16, and 12 in a fixed relationship to the support base 11, i.e., prevents the shaft and cylinders from telescoping into one another after the required extension has been established.

As can now be appreciated, there is no support in Lee for the position that one of ordinary skill in the art would modify Lee to include the clamp assembly as taught by EP '704 in order to prevent the second conduit from sliding into the first conduit once the required extension of the second conduit has been established. Since there is no basis to combine Lee and EP '704, the combination is prompted by Applicants' claims. Therefore, the combination of Lee and EP '704 is made using hindsight and, as such, the combination is not acceptable to reject claims 1 and 8-10.

For the sake of discussion only and not admitting that one skilled in the art would combine Lee and EP '704, the combination would render Applicants' claim 1 obvious. More particularly, claim 1 recites, among other things, that a second conduit is slidably received in a hollow first conduit, a ring on the second conduit, and a handle connected to the ring and the first conduit. Lee, on the other hand, discloses a ring on the fourth conduit and a pair of handles on the base conduit 12 and the ring. The threaded conduit having the ring is not shown nor disclosed by Lee to be slidable in the base conduit 12.

Based on the foregoing, Applicants respectfully request withdrawal of the rejection of claims 1 and 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of EP '704 and request allowance of claims 1 and 8-10.

Claims 2-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of EP '704, as applied to claim 1 above, and further in view of U.S. Patent No. 844,385 to Mommertz. The Office Action alleges that Lee (once modified) discloses the invention substantially as claimed and states that Lee (once modified) lacks wedging members. The Office Action continues by alleging that Mommertz teaches wedging

members (see Figs.) and that it would have been considered obvious to one of ordinary skill in the art to further modify the (once modified) Lee to include the wedging members as taught by Mommertz to prevent the second conduit from sliding into the first conduit once the required extension of the second conduit has been established.

Applicants respectfully traverse the rejection of claims 2-5 under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of EP '704 and further in view of Mommertz and request reconsideration thereof. Claims 2-5 are either directly or indirectly dependent on claim 1. Claim 1, Lee, and EP '704 were discussed above.

The Office Action combines Mommertz with Lee, after Lee is modified by including the disclosure of EP '704. Applicants have shown above that one skilled in the art, without the knowledge of Applicants' claims, would not combine Lee and EP '704. Therefore, Lee would not be modified as alleged by the Office Action. Assuming for the sake of discussion only, and not admitting that one skilled in the art would combine Lee and Mommertz, that the combination of Lee and Mommertz would not render obvious the subject matter of claims 1 and 2-5 because, among other things, as shown above, one skilled in the art would not modify Lee as alleged by the Office Action and, if Lee was combined with EP '704, the subject matter of claim 1 would not be obvious.

Based on the foregoing, Applicants respectfully request withdrawal of the rejection of claims 2-5 under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of EP '704 and further in view of Mommertz and request allowance of claims 2-5.

Claims 12 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of EP '704, as applied to claim 1 above, and further in view of U.S. Patent No. 2,068,491 to Jakoubek et al. (hereinafter also referred to as "Jakoubek"). The Office Action alleges that Lee (once modified) discloses the invention substantially as claimed and states that Lee (once modified) lacks visual indicator. The Office Action continues by alleging that Jakoubek teaches visual indicator (30) and that it would have been considered obvious to one of ordinary skill in the art to further modify the (once modified) Lee to include visual indicator as taught by Jakoubek to prevent overextending of the second conduit.

Applicants respectfully traverse the rejection of claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of EP '704 and further in view of

Jakoubek and request reconsideration thereof. Claims 12 and 13 are either directly or indirectly dependent on claim 1. Claim 1, Lee, and EP '704 were discussed above.

The Office Action combines Jakoubek with Lee and EP '704 after Lee is modified by the disclosure of EP '704. Applicants have shown above that one skilled in the art, without the knowledge of Applicants' claims, would not combine Lee and EP '704. Therefore, Lee would not be modified as alleged by the Office Action. Assuming for the sake of discussion only, and not admitting that one skilled in the art would combine Lee and Jakoubek, that the combination of Lee and Jakoubek would not render obvious the subject matter of claims 1, 12, and 13 because, among other things, as shown above, one skilled in the art would not modify Lee as alleged by the Office Action and, if Lee was combined with EP '704, the subject matter of claim 1 would not be obvious.

Based on the foregoing, Applicants respectfully request withdrawal of the rejection of claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of EP '704 and further in view of Jakoubek and request allowance of claims 12 and 13.

Applicants, by this Amendment, have added new claims 16-23, which are directly or indirectly dependent on claim 1. Support for new claims 16-23 is found, among other places, in the originally filed claims and the figures. Based on the foregoing, Applicants respectfully request admittance and consideration of new claims 16-23. The arguments put forth to patentably distinguish claim 1 over the art is applicable, among others, to patentably distinguish new claims 16-23 over similar art. Based on the foregoing, Applicants respectfully request allowance of new claims 16-23.

Application No. 10/687,960
Paper Dated: November 30, 2004
In Reply to USPTO Correspondence of August 31, 2004
Attorney Docket No. 2202-031542

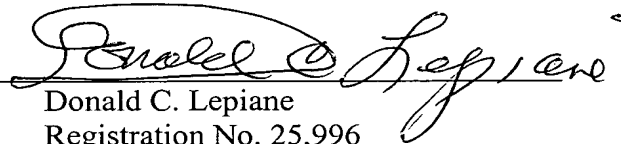
Conclusion

This Amendment is deemed to place the application in condition for allowance. In the event issues remain, the Examiner is invited to call the undersigned before further action is taken on the case.

Respectfully submitted,

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By

A handwritten signature in cursive script, appearing to read "Donald C. Lepiane", written over a horizontal line.

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AMENDMENT TO THE DRAWINGS

The attached sheet of drawings includes changes to Fig. 11. This sheet, which includes Figs. 11-14, replaces the original sheet including Figs. 11-14. In Fig. 11, "Prior Art" has been added.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

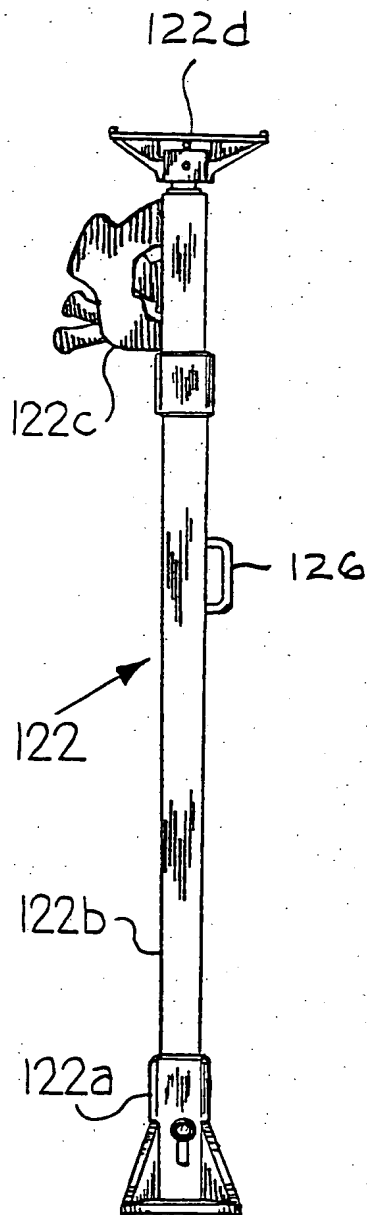


Fig. 11
Prior Art

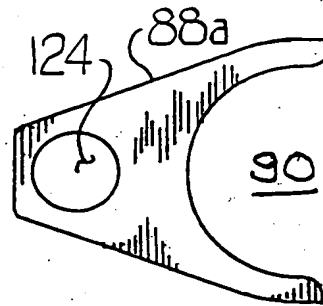


Fig. 12

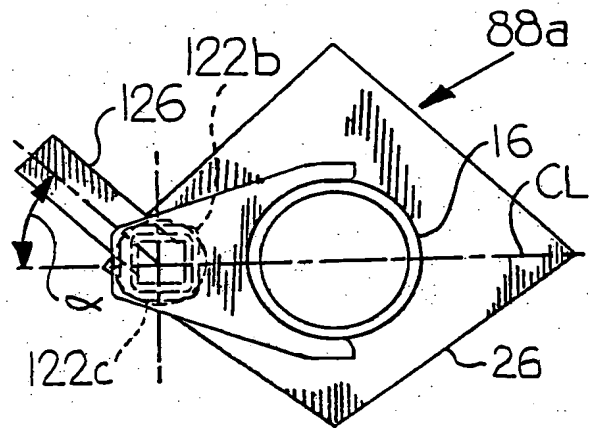


Fig. 13

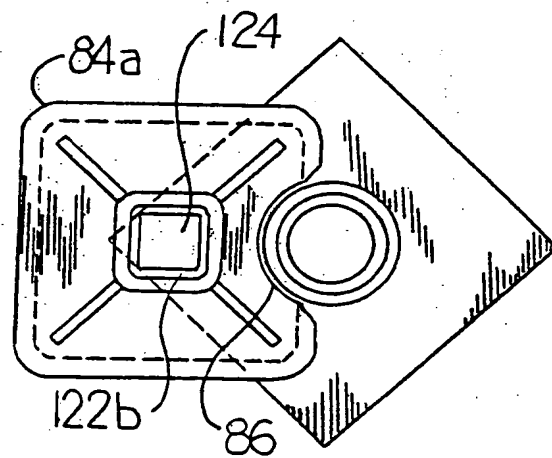


Fig. 14